Supreme Court, U.S.
FILED
JAN 15 2016
OFFICE OF THE CLERK

No. 15-777

IN THE

Supreme Court of the United States

SAMSUNG ELECTRONICS CO., LTD., *et al.*,

Petitioners,

v.

APPLE INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF *AMICI CURIAE* OF 37 INTELLECTUAL PROPERTY PROFESSORS IN SUPPORT OF PETITION FOR CERTIORARI

MARK A. LEMLEY
Counsel of Record
STANFORD LAW SCHOOL
559 Nathan Abbott Way
Stanford, CA 94305
(650) 723-4605
mlemley@law.stanford.edu

Counsel for Amici Curiae

263583

COUNSEL PRESS
(800) 274-3321 • (800) 359-6859

TABLE OF CONTENTS

Page

TABLE OF CONTENTS..... i

TABLE OF CITED AUTHORITIES iii

INTEREST OF *AMICI* 1

SUMMARY OF ARGUMENT..... 1

ARGUMENT..... 3

II. The Federal Circuit's Functionality Doctrine Gives Unwarranted Scope to Design Patents and Undermines the Promotion of Technological Progress..... 3

A. The Federal Circuit's Design Patent Functionality Doctrine Is Inconsistent with this Court's Constitutionally-Grounded Approach to Trade Dress Functionality 3

B. The Federal Circuit's Infringement Approach Permits Design Patent Owners Exclusivity over Functional Aspects of Designs 5

II. The Federal Circuit's Decision Limit Profits to Those Attributable to the Patented Design Produces Absurd Results..... 9

Table of Contents

Page

A. The Origin and Context of Section 289 9

B. Awarding a Defendant's Entire Profits Makes No Sense in the Modern World 11

C. Section 289 Does Not Require Disgorgement of Profits Unrelated to the Patented Design 15

IV. Conclusion 18

TABLE OF CITED AUTHORITIES

Page

CASES

Avia Group Int'l, Inc. v. L.A. Gear of Cal.,
853 F.2d 1557 (Fed. Cir. 1988) 4

Best Lock Corp. v. Ilco Unican Corp.,
94 F.3d 1563 (Fed Cir. 1996) 4

Bush & Lane Piano Co. v. Becker Bros.,
222 F. 902 (2d Cir. 1915) 16

Chrysler Motors Corp. v.
Auto Body Panels of Ohio, Inc.,
908 F.2d 951 (Fed. Cir. 1990) 5

Dobson v. Bigelow Carpet Co.,
114 U.S. 439 (1885).....10

Dobson v. Dornan,
118 U.S. 10 (1886).....10

Dobson v. Hartford Carpet Co.,
114 U.S. 439 (1885).....10

Egyptian Goddess, Inc. v. Swisa, Inc.,
543 F.3d 665 (Fed. Cir. 2008) 5, 6, 7

Garretson v. Clark,
111 U.S. 120 (1884).....10

Cited Authorities

Page

Gorham Co. v. White,
81 U.S. 511 (1871) 3

Graham v. John Deere Co.,
383 U.S. 1 (1966) 3-4

Int'l Seaway Trading Corp. v. Walgreens Corp.,
589 F.3d 1233 (Fed. Cir. 2009) 6

KSR Int'l Co. v. Teleflex, Inc.,
550 U.S. 398 (2007) 4

Lee v. Dayton-Hudson Corp.,
838 F.2d 1186 (Fed. Cir. 1988) 6

PHG Technologies, LLC v.
St. John Companies, Inc.,
469 F.3d 1361 (2006) 5

Power Controls Corp. v. Hybrinetics, Inc.,
806 F.2d 234 (Fed. Cir. 1986) 4

Richardson v. Stanley Works, Inc.,
597 F.3d 1288 (Fed. Cir. 2010) 6, 7

Seiko Epson Corp. v. Nu-Kote Int'l, Inc.,
190 F.3d 1360 (Fed. Cir. 1999) 4

Seymour v. McCormick,
57 U.S. 480 (1853) 14

Cited Authorities

Page

Taylor v. Meirick,
712 F.2d 1112 (7th Cir. 1983).....16

TrafFix Devices, Inc. v.
Marketing Displays, Inc.,
532 U.S. 23 (2001).....4, 5, 9

Uniloc USA, Inc. v. Microsoft Corp.,
632 F.3d 1292 (Fed. Cir. 2011) 13

Weber-Stephen Prods. LLC v.
Sears Holding Corp.,
2014 WL 5333364 (N.D. Ill. October 20, 2014).....7

Young v. Grand Rapids Refrigerator Co.,
268 F. 966 (6th Cir. 1920).....16

STATUTES AND OTHER AUTHORITIES

18 CONG. REC. 836 (1887).....10, 11

35 U.S.C. § 171(a).....3

35 U.S.C. § 289..... *passim*

1952 Patent Act 17

Act of Feb. 4, 1887, ch. 105, § 1, 24 Stat. 387 .....10, 11

H.R. REP. NO. 49-1966.....10, 11

Page

David Drummond, *When Patents Attack Android*, Google Official Blog (Aug. 3, 2011) 13

Frederic H. Betts, *Some Questions Under the Design Patent Act of 1887*, 1 Yale L.J. 181 (1892) 17

Jason J. Du Mont & Mark D. Janis, *Virtual Designs*, 17 Stan. Tech. L. Rev. 107 (2013).....11

Mark A. Lemley & Mark P. McKenna, *Scope*, __ Wm. & Mary L. Rev. __ (forthcoming 2016).....6

Mark A. Lemley, *A Rational System of Design Patent Remedies*, 17 Stan. Tech. L. Rev. 219 (2013) 14, 17

Mark A. Lemley, *Point of Novelty*, 105 Nw. U. L. Rev. 1253 (2011).....6

Mark P. McKenna & Katherine J. Strandburg, *Progress and Competition in Design*, 17 Stan. Tech. L. Rev. 1 (2014) 4

Michael Risch, *Functionality and Graphical User Interface Design Patents*, 17 Stan. Tech. L. Rev. 53 (2014).....4

INTEREST OF *AMICI*

Amici are law and business school professors at schools throughout the United States.[1] We have no personal interest in the outcome of this case, but a professional interest in seeing that patent law develops in a way that encourages rather than retards innovation and creativity. Institutional affiliations are given for identification purposes only.

SUMMARY OF ARGUMENT

This case presents two issues that justify this Court's review.

First, the Federal Circuit upheld a finding of design patent infringement based on the very same Apple designs that it found functional under trade dress law. Such a counterintuitive outcome is possible because the Federal Circuit has constructed a highly constrained definition of functionality in design patent law, which is at odds with this Court's precedent in both utility patent and trade dress cases. Coupled with its recent re-interpretation of the design patent infringement standard, the Federal Circuit's approach to functionality makes it quite likely that defendants will be held liable for doing nothing more than implementing functional features that could not be protected with utility patents. This Court should grant

1. No counsel for a party authored this brief in whole or in part, and no such counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than the amici, or their counsel, made a monetary contribution intended to fund its preparation or submission. The parties have consented to the filing of this brief.

review to address the relationship of functionality to design patent infringement.

Second, despite Samsung's own patents, its engineering and design work, and the fact that technologies developed by Google and countless other inventors are incorporated in Samsung's phones, the Federal Circuit affirmed the jury's damages award of Samsung's entire profit from phones that were held to infringe Apple's design patents. Under the Federal Circuit's reading of 35 U.S.C. §289, design patent infringers, unlike infringers of copyrights, trademarks, or utility patents on technical inventions, are liable for their entire profits from an infringing product, even if the patented design is only a minor feature of that product.

That draconian rule is in conflict with both the Second's and Sixth Circuit's statutory interpretations, dates back more than a century to circumstances that no longer apply today, and is inconsistent with this Court's rule for utility patent damages. As applied to a modern, multicomponent product, the entire profit rule drastically overcompensates design patent owners, undervalues technological innovation and manufacturing know-how, and raises troubling questions about how to handle other potential claims to a share of the defendant's profits. The rule applies even to innocent design patent infringement, which recent Federal Circuit infringement precedent has rendered more likely.

This Court should grant certiorari to review the meaning of section 289, an issue it has never addressed. Section 289 should be read, in accordance with wise policy and the remainder of the patent statute, to limit

the award of profits to those attributable to infringement of the design patent.

ARGUMENT

II. The Federal Circuit's Functionality Doctrine Gives Unwarranted Scope to Design Patents and Undermines the Promotion of Technological Progress

A. The Federal Circuit's Design Patent Functionality Doctrine Is Inconsistent with this Court's Constitutionally-Grounded Approach to Trade Dress Functionality

The basic rule of design patent infringement has been the same since *Gorham Co. v. White*, which held that a design patent is infringed "if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other." 81 U.S. 511, 528 (1871). Crucially, design patents protect only ornamentation. They may not cover the functional aspects of a product. 35 U.S.C. § 171(a) ("a design patent may only be granted for a "new, original, and *ornamental* design").

Functionality doctrine channels protection for a product's visual ornamentation and shape toward design patent protection, while claims to useful solutions are directed to utility patents. The doctrine prevents parties from obtaining a patent on the functional aspects of inventions that are obvious, a limitation this Court has held is constitutionally required. *Graham v. John Deere*

Co., 383 U.S. 1, 5-6 (1966); *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 427 (2007). Utility patent doctrine aims to balance protections needed to induce invention with follow-on inventors' need to build on prior technologies and to ensure access to technologies in the public domain. In the trade dress context, this Court has recognized that overreaching protection can undermine this balance and must be reined in by the functionality doctrine. *See TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 29-30, 34 (2001) ("The Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity.")

The Federal Circuit has eviscerated the functionality doctrine in design patent law, narrowing it almost to the point of nonexistence. *See, e.g.*, Mark P. McKenna & Katherine J. Strandburg, *Progress and Competition in Design*, 17 STAN. TECH. L. REV. 1 (2014); Michael Risch, *Functionality and Graphical User Interface Design Patents*, 17 STAN. TECH. L. REV. 53 (2014). Under the Federal Circuit's reading, a design is functional—and thus unprotectable—only if there is no other possible way to achieve the same technological utility. *Avia Group Int'l, Inc. v. L.A. Gear of Cal.*, 853 F.2d 1557, 1563 (Fed. Cir. 1988); *Seiko Epson Corp. v. Nu-Kote Int'l, Inc.*, 190 F.3d 1360, 1368 (Fed. Cir. 1999) (design is functional only if it is "the only possible form of the article that could perform its function."). Needless to say, that almost never happens. Indeed, the Federal Circuit has found a claimed design functional in only two published opinions, both issued before 1996.[2]

---

2. *Best Lock Corp. v. Ilco Unican Corp.*, 94 F.3d 1563, 1566-57 (Fed Cir. 1996); *Power Controls Corp. v. Hybrinetics, Inc.*, 806 F.2d 234 (Fed. Cir. 1986). The Federal Circuit remanded on the

The Federal Circuit's "only possible form" standard for design patent functionality is much narrower than this Court's functionality standard for trade dress, under which a feature is functional not only if it "is essential to the use or purpose of the article" being sold, but also if "it affects the cost or quality of the article." *TrafFix*, 532 U.S. at 35. The inconsistency between the doctrines is evident in this very case. The Federal Circuit held Apple's trade dress invalid as functional, but it affirmed liability for infringement of design patents on the very same features. There is no justification in statutory text, history, or policy for interpreting functionality differently for design patents than for trade dress. This Court should harmonize the design patent functionality doctrine with its functionality precedents in trade dress law.

B. The Federal Circuit's Infringement Approach Permits Design Patent Owners Exclusivity over Functional Aspects of Designs

Recent developments in design patent infringement doctrine exacerbate the dangers in the Federal Circuit's meager view of functionality, making it even more likely that design patents will give their owners unwarranted control over utilitarian features. Design patent infringement is determined by asking "whether an ordinary observer, familiar with the prior art, would be deceived into thinking that the accused design was the same as the patented design." *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 672 (Fed. Cir. 2008) (en banc). Before 2008, courts applied

---

issue in two other cases. *PHG Technologies, LLC v. St. John Companies, Inc.*, 469 F.3d 1361 (2006); *Chrysler Motors Corp. v. Auto Body Panels of Ohio, Inc.*, 908 F.2d 951 (Fed. Cir. 1990).

a "point of novelty" approach to the comparison, finding infringement only if the accused design incorporated novel and nonobvious aspects of the patentee's claimed design. *Id.* at 670-71.[3] The Federal Circuit rejected that approach, holding that the ordinary observer test is the "sole test" for determining infringement, *id.* at 678,[4] even when "the patented design incorporates numerous functional elements." *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1295 (Fed. Cir. 2010).

Many design patents cover designs that include clearly functional features, and many cover designs whose ornamentality in any ordinary sense of the term is questionable at best. *See* Mark A. Lemley & Mark P. McKenna, *Scope*, __ Wm. & Mary L. Rev. __ (forthcoming 2016), available at http://ssrn.com/abstract=2660951. But under current Federal Circuit law, the jury is no longer required to exclude those functional elements from consideration when it decides infringement. Under the Federal Circuit's unguided ordinary observer test, it is all too possible that a design patent owner will be able to prevent competitors from copying utilitarian features that are unprotectable under utility patent law.

---

3. *See also Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1188 (Fed. Cir. 1988) ("it is the non-functional, design aspects that are pertinent to determinations of infringement").

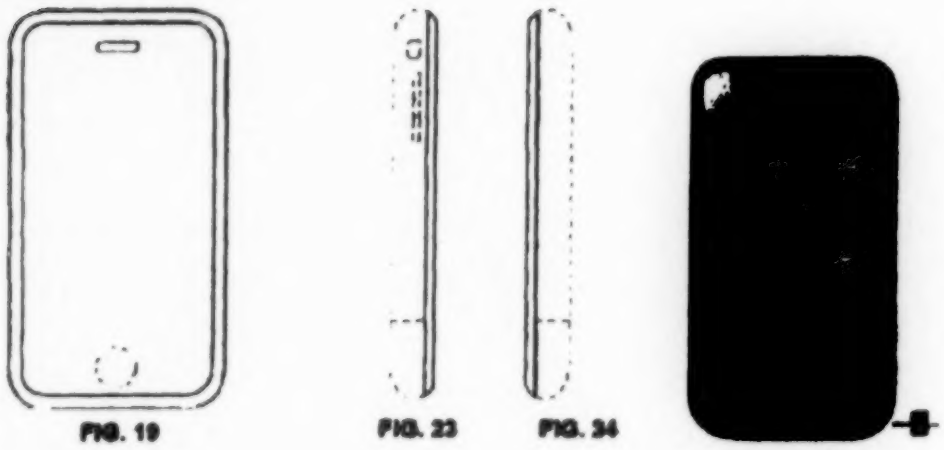
4. The Federal Circuit has also concluded that points of novelty no longer are relevant to design patent validity. *See, e.g., Int'l Seaway Trading Corp. v. Walgreens Corp.*, 589 F.3d 1233, 1237–38 (Fed. Cir. 2009); Mark A. Lemley, *Point of Novelty*, 105 Nw. U. L. Rev. 1253 (2011).

The Federal Circuit's analysis in *Richardson* suggested that the problems caused by the *Egyptian Goddess* infringement test might be mitigated by construing design patent claims in light of "the distinction between the functional and ornamental aspects of a design." 597 F.3d at 1293. The district court in that case, after identifying the ornamental aspects of the patented tool design, had deemed the accused design noninfringing because its only similarities to the claimed design related to unprotectable functional elements. *Id.* at 1295. The Federal Circuit affirmed, "agree[ing] that, ignoring the functional elements of the tools, the two designs are indeed different." *Id.* at 1296.

Subsequent developments have limited the effectiveness of the *Richardson* approach, however. The Federal Circuit has not required district courts to apply *Richardson* and filter out the unprotectable elements of a design. Moreover, district courts have had trouble applying *Richardson* in the common circumstance in which claim construction and functionality are handled separately. *See, e.g., Weber-Stephen Prods. LLC v. Sears Holding Corp.*, 2014 WL 5333364 (N.D. Ill. October 20, 2014) ("unlike the typical case, the *Richardson* trial court was able to consider claim construction and functionality together, with the benefit of a fully developed record at trial").

The Federal Circuit's opinion in the present case weakens *Richardson* still further by ruling that the ordinary observer should not ignore utilitarian aspects of the products in comparing the designs and that claims should not be construed to eliminate elements that are structural or "dictated by their functional purpose." 786

F.3d at 998. The court also deemed it unnecessary to instruct jury members to compare only the ornamental appearance of the accused product with the claimed design, as long as the instructions "as a whole" informed them that the patents claimed "the ornamental design" of the devices – a black-letter definition of a design patent. *Id.* at 999.



The facts of this case illustrate the importance of these doctrinal developments. Apple's patented design for the iPhone is shown at the left of the figure above. One of Samsung's accused phones is shown at the right. The trade dress analysis in the opinion recognizes that many features of Apple's design, such as rounded corners, a flat clear screen, and a bezel, are functional. Moreover, Apple was not the first to come up with a mobile computer with similar features.

An infringement analysis that excluded from the comparison design elements that were functional or in the prior art would recognize the narrowness of the patentable aspects of Apple's design and ask whether Samsung's products appropriated those aspects of the design that make it patentable.

By moving away from that approach and emphasizing the ordinary observer's comparison of the overall designs, the Federal Circuit creates a significant risk that a patentee will prevail even if an observer would find the two designs similar only because they share features that are functional or in the prior art.

This Court has made clear that the functionality doctrine exists to protect the public's right to make use of functional characteristics that are unpatentable or no longer protected by a utility patent. *TrafFix*, 532 U.S. at 29-30. Giving a design patent owner control over utilitarian features undermines the policy goals of the functionality doctrine. But that is precisely what results from the Federal Circuit's interpretation of design patent functionality and infringement law. This Court should grant review in order to align design patent law with the important policy goals of the functionality doctrine and render it consistent with the long-standing rules of utility patent and trade dress law.

II. The Federal Circuit's Decision Limit Profits to Those Attributable to the Patented Design Produces Absurd Results

A. The Origin and Context of Section 289

Patent law has long included a damages apportionment principle. While early patents tended to be on fairly simple machines or chemical inventions, the industrial revolution brought patents on small parts of large, multicomponent inventions, such as locomotives. When courts awarded damages or defendant's profits for infringement of such patents, they awarded damages attributable to the patent rather than to the defendant's product as a whole.

In *Garretson v. Clark*, for example, this Court said the patentee "must in every case give evidence tending to separate or apportion the defendant's profits and the patentee's damages between the patented feature and the unpatented features . . . ." 111 U.S. 120, 121 (1884).

In the nineteenth century, design patents were treated no differently. In the *Dobson* cases, involving carpets, this Court found that, while the design patents at issue had been infringed, there was no evidence by which a factfinder could distinguish the value of the patented design from the value of the unpatented carpet itself. As a result, the Court ultimately awarded only nominal damages of $0.06. *Dobson v. Dornan*, 118 U.S. 10, 18 (1886); *Dobson v. Bigelow Carpet Co.*, 114 U.S. 439 (1885); *Dobson v. Hartford Carpet Co.*, 114 U.S. 439 (1885). That result incensed many.

In 1887, when Congress rewrote the Patent Act, it responded to these concerns by passing a new provision addressing design patent infringement. That provision set a floor of $250 for design patent damages and made a defendant "further liable for the excess of such profit over and above" $250. Act of Feb. 4, 1887, ch. 105, § 1, 24 Stat. 387, 387. The 1887 Act made defendants liable only for knowing acts of design patent infringement, mitigating any potential unfairness of the Act's damages rule. As Representative Butterworth put it, "no man will suffer either penalty or damage unless he willfully appropriates the property of another." 18 CONG. REC. 836 (1887). The House Report similarly assured that "an innocent dealer or user is not affected." H.R. REP. NO. 49-1966, at 4.

B. Awarding a Defendant's Entire Profits Makes No Sense in the Modern World

The design patent damages provision remains, albeit in substantially modified form, in what is now section 289 of the Patent Act. Nowadays, however, design patent infringement, like utility patent infringement, is a strict liability claim, no longer requiring the knowing appropriation emphasized by Congress when passing the 1887 Act.

Congress's 1887 assumption that "it is the design that sells the article"[5] may still be true of carpets, but it surely is not true of all products covered by design patents today. The likelihood that a product incorporates more than one patented design is much greater than it was in 1887. Design patents on virtual features, such as icons, are particularly likely to overlap, and there are more and more of them. Jason J. Du Mont & Mark D. Janis, *Virtual Designs*, 17 STAN. TECH. L. REV. 107 (2013) (documenting the growth of virtual design patents). If there is more than one patented design in a product, the assumption that any particular patented design drives the sale of the product falls apart.

That is what has happened in this case. Here is one of Apple's many design patents on its iPhone.[6]

---

5. H.R. REP. No. 49-1966, at 3 (1886), *reprinted in* 18 CONG. REC. 834 (1887).

6. U.S. Patent No. D618,677. fig.1 (filed Nov. 18, 2008).

Here is another Apple iPhone design patent.[7]

It is (barely) possible to argue with a straight face that it is the shape and overall ornamental design of the iPhone, rather than its functionality, that motivates consumers to buy it. It is not even remotely plausible that the shape of the Apple iTunes icon is what motivates people to buy the whole iPhone. And it literally cannot be the case that the phone shape patent and the iTunes icon patent are *each*

7. U.S. Patent No. D668,263. fig.1 (filed Oct. 8, 2010).

the sole driver of a consumer buying the phone. Notably, all of the patents Apple asserted in this litigation cover discrete parts, rather than the entire phone. And while these patents on different aspects of the iPhone's design happen to be owned by the same company, there is no reason to think that the same will always be the case for similarly complex products.

Nor does all, or even most, of the value of a product come from patented designs. People do not buy iPhones for their appearance alone; they buy them for their functions. Those functions contribute substantially to the phone's value and they are covered by many utility patents. Indeed, by one estimate, there are 250,000 patents that arguably cover various aspects of a smartphone.[8] To conclude that one design patent drives the purchase of the product, and therefore that the defendant's entire profit is attributable to infringing that patent, is to say that none of those functional features contribute anything to the value of the phone – a ludicrous proposition.

Indeed, for most products (excluding, say, fashion) it is more plausible that a functional feature covered by a utility patent drives demand than that a patented design feature does. Yet even utility patent owners rarely are awarded damages based on the entire value of the product. In the rare case where that does happen, the utility patent owner must have proved that the patent was the basis for market demand. *Uniloc USA, Inc. v. Microsoft Corp.*, 632 F.3d 1292, 1318 (Fed. Cir. 2011). The Federal Circuit's interpretation of section 289 requires no such

---

8. *See* David Drummond, *When Patents Attack Android*, Google Official Blog (Aug. 3, 2011), http://googleblog.blogspot.com/2011/08/when-patents-attack-android.html.

proof. It simply assumes that the only valuable thing about a product is its design. That assumption is not plausible in the modern world. *See* Mark A. Lemley, *A Rational System of Design Patent Remedies*, 17 STAN. TECH. L. REV. 219, 233 (2013).

Further, awarding the defendant's entire profit based on a plaintiff's small contribution to a product's value would cause significant mischief, as this Court noted in *Seymour v. McCormick*, 57 U.S. 480 (1853):

> If the measure of damages be the same whether a patent be for an entire machine or for some improvement in some part of it, then it follows that each one who has patented an improvement in any portion of a steam engine or other complex machines may recover the whole profits arising from the skill, labor, material, and capital employed in making the whole machine, and the unfortunate mechanic may be compelled to pay treble his whole profits to each of a dozen or more several inventors of some small improvement in the engine he has built. By this doctrine even the smallest part is made equal to the whole, and 'actual damages' to the plaintiff may be converted into an unlimited series of penalties on the defendant.
>
> We think, therefore, that it is a very grave error to instruct a jury 'that as to the measure of damages the same rule is to govern, whether the patent covers an entire machine or an improvement on a machine.'

Id. at 490-91.

C. Section 289 Does Not Require Disgorgement of Profits Unrelated to the Patented Design

The proper interpretation of section 289 should consider the provision as a whole. Section 289 currently reads in its entirety:

> Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied ***shall be liable to the owner to the extent of his total profit***, but not less than $250, recoverable in any United States district court having jurisdiction of the parties.
>
> Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, ***but he shall not twice recover the profit made from the infringement***.

35 U.S.C. §289 (emphasis added).

Section 289 does say that a defendant is "liable to the owner to the extent of his total profit." Read literally, that general language might permit damages beyond profits from the sale of the infringing product. Nonetheless, basic principles of remedies law require a plaintiff to show some connection between the damages and the infringement. As the Seventh Circuit put it in the copyright context, a

plaintiff must do more than simply attach the defendant's income tax return to the complaint and say it wants all the money that defendant made from whatever source.[9]

That basic principle has been applied in design patent cases as well. Indeed, in one early design patent case, in which the defendant sold refrigerators with door latches that infringed the plaintiff's patent, the court refused to award the entire profits from refrigerators, instead defaulting to the $250 statutory minimum because the latch was not sold separately. *Young v. Grand Rapids Refrigerator Co.*, 268 F. 966, 973-74 (6th Cir. 1920). The court required a connection between the design patent and the profits awarded, and held that the owner of a patent on a latch was not entitled to the entire profit on the refrigerator. Similarly, the court in *Bush & Lane Piano Co. v. Becker Bros.*, 222 F. 902 (2d Cir. 1915) opined:

> The question which seems to have received little attention upon the accounting, due probably to the form of the decree, is whether the profits made by the defendant should be the entire profits of the sales of the piano and case or the profits upon the sale of the case which alone is the sole subject of the patent. We are of the opinion that the latter rule should have controlled the accounting.

---

9. *Taylor v. Meirick*, 712 F.2d 1112, 1122 (7th Cir. 1983) ("If General Motors were to steal your copyright and put it in a sales brochure, you could not just put a copy of General Motors' corporate income tax return in the record and rest your case for an award of infringer's profits.").

Id. at 903; *see also* Lemley, *supra*, at 235; Frederic H. Betts, *Some Questions Under the Design Patent Act of 1887*, 1 YALE L.J. 181 (1892).

The final paragraph of section 289, prohibiting double counting of the defendant's profits and the plaintiff's losses, also supports awarding only the profits attributable to the patented design. In defining "double counting," the statute refers to the defendant's profits measure as "the profit made from the infringement." 35 U.S.C. §289. That language clearly contemplates a focus on the profits attributable to the patented design: the profit at issue in a design patent case is not the defendant's total profit, or even defendant's total profit from a single product, but the profit "made from"—that is, causally derived from—"the infringement."

Further evidence in support of that interpretation comes from another change to the statutory language. The 1952 Patent Act deleted language from the original statute awarding profits "made by him from the manufacture or sale, as aforesaid, of the article or articles to which the design, or colorable imitation thereof, has been applied." That original language suggested that the profit to be awarded was that associated with the articles as a whole, rather than only that profit attributable to the patented design. The deletion of that language, coupled with the reference in the second paragraph to "profits made from the infringement," suggests an interpretation of section 289 that awards only those profits attributable to the patented design.

IV. Conclusion

This Court should grant certiorari to restore functionality to its proper role in validity and infringement inquiries and to reverse the Federal Circuit's interpretation of section 289.

Respectfully submitted,

MARK A. LEMLEY
Counsel of Record
STANFORD LAW SCHOOL
559 Nathan Abbott Way
Stanford, CA 94305
(650) 723-4605
mlemley@law.stanford.edu

Counsel for Amici Curiae

APPENDIX

APPENDIX — LIST OF SIGNATORIES[10]

John R. Allison
McCombs Graduate School of Business,
University of Texas at Austin

Margo A. Bagley
University of Virginia School of Law

Mark Bartholomew
SUNY Buffalo Law School

Ann Bartow
University of New Hampshire School of Law

James Bessen
Boston University School of Law

Jeremy Bock
University of Memphis Cecil B. Humphreys
School of Law

Michael A. Carrier
Rutgers Law School

Bernard Chao
University of Denver Sturm College of Law

---

10. Institutions are listed for affiliation purposes only. All signatories are participating in their individual capacity, not on behalf of their institutions.

Appendix

Colleen V. Chien
Santa Clara University School of Law

Charles Colman
New York University School of Law
University of Hawaii William S. Richardson School of Law (beginning 2016)

Ralph D. Clifford
University of Massachusetts School of Law

William T. Gallagher
Golden Gate University School of Law

Jon M. Garon
Nova Southeastern University Shepard Broad College of Law

Jim Gibson
University of Richmond School of Law

Eric Goldman
Santa Clara University School of Law

Stuart Graham
Scheller College of Business, Georgia Institute of Technology

Wendy J. Gordon
Boston University School of Law

Appendix

Michael Grynberg
DePaul University College of Law

Laura A. Heymann
William & Mary Law School

Amy Landers
Drexel University Thomas Kline School of Law

Stacy Lantagne
University of Mississippi School of Law

Lawrence Lessig
Harvard Law School

Mark A. Lemley
Stanford Law School

Yvette Joy Liebesman
St. Louis University School of Law

Brian J. Love
Santa Clara University School of Law

Gregory N. Mandel
Temple University Beasley School of Law

Stephen McJohn
Suffolk University School of Law

Mark P. McKenna
Notre Dame Law School

Appendix

Tyler T. Ochoa
Santa Clara University School of Lawc

Michael Risch
Villanova University School of Law

Matthew Sag
Loyola University Chicago School of Law

Pamela Samuelson
Berkeley Law School

Jessica Silbey
Northeastern University School of Law

Christopher Jon Sprigman
New York University School of Law

Katherine Strandburg
New York University School of Law

Rebecca Tushnet
Georgetown University Law Center

Ryan Vacca
University of Akron School of Law